

ATTORNEY DOCKET NO.: 14014.0346U1
SERIAL NO.: 09/762,538**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Egan, *et al.*

Serial No.: 09/762,538

Filed: February 8, 2001

For: "DIFFERENTIATION OF NON-INSULIN :
PRODUCING CELLS INTO INSULIN :
PRODUCING CELLS BY GLP-1 OR :
EXENDIN-4 AND USES THEREFORE" :

Group Art Unit: 1646

Examiner: Jiang, Dong

Confirmation No. 5705

RESPONSE TO RESTRICTION REQUIREMENT**VIA FACSIMILE**

Attn: Examiner Dong Jiang

703-308-0294

Commissioner for Patents

Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C.

The Candler Building

127 Peachtree Street, N.E.

Atlanta, Georgia 30303-1811

October 28, 2002

Sir:

In response to the restriction requirement of June 24, 2002, applicants provisionally elect Group II with traverse. The claims have been restricted to Group I (claims 1-11, 23-26, 31, and 32), Group II (claims 12-22, 27-30, 31, and 33), Group III (claims 34 and 35), Group IV (claims 36-38), Group V (claims 39-41), Group VI (claims 42-44), Group VII (claims 45-48), and Group VIII (claims 49-52). Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction to be proper, the Examiner must satisfy the following two criteria: (1) the

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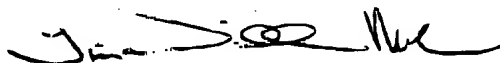
existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803.

The Examiner has not shown that the **second** requirement has been met. Specifically the Examiner has not shown that it would be a serious burden to search and examine both groups together. In particular, Groups II and IV are related, as the claims of Group IV are directed to an *in vivo* use of a method of differentiating insulin-producing cells using exendin-4 and the claims of Group II are directed to the method of differentiation. The method and its *in vivo* use can readily be examined together without serious burden to the Examiner. Furthermore, Group IV includes only three claims and it would not create a burden to search along with the claims of Group II. Consequently, applicants request reconsideration or withdrawal of the restriction requirement.

No fee is believed to be due at this time. However, the Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 14-0629

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

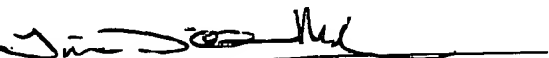


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and anything indicated as being attached or included is being transmitted via Facsimile No. 703-308-0294 addressed to: Examiner Dong Jiang, Ph.D., Group Art Unit 1646, U.S. Patent and Trademark Office, on the date shown below.


Tina Williams McKeon

October 28, 2002
Date

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IMPORTANT FAX DOCUMENT

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FROM Tina W. McKeon, Ph.D.

REFERENCE NO. 14014.0346U1 Application No. 09/762,538

OUR FAX NUMBER 404-688-9880

NUMBER OF PAGES 3

Attached: Response to Restriction Requirement (2 pages)

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